



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/082,601	02/22/2002	Satoshi Nakajima	109908-130337	5731

25943 7590 01/25/2008
SCHWABE, WILLIAMSON & WYATT, P.C.
PACWEST CENTER, SUITE 1900
1211 SW FIFTH AVENUE
PORTLAND, OR 97204

EXAMINER

DOAN, DUYEN MY

ART UNIT	PAPER NUMBER
----------	--------------

2152

MAIL DATE	DELIVERY MODE
-----------	---------------

01/25/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/082,601

Applicant(s)

NAKAJIMA, SATOSHI

Examiner

Duyen M. Doan

Art Unit

2152

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 October 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 7-20 and 27-40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 7-20 and 27-40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 February 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/24/2007 has been entered.

Claims 7-20, 27-40 are amended for examination. Claims 1-6, 21-26 are cancelled.

Response to Arguments

Applicant's arguments, filed 10/24/2007 (pages 9-10) with respect to rejections under 35 U.S.C. 112 first and second paragraph have been fully considered and found persuasive. Therefore, claim rejections under 35 U.S.C. 112 first and second paragraph are hereby withdrawn.

Applicant's arguments with respect to rejection under 35 U.S.C. 102(b), 102(e) and 103(a) have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 27-34 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Independent claim 27 cited, "without independently of the source application".

The limitation "without independently of the source application" would imply "dependently on the source application, on page 8, lines 25-21 of the specification discloses the binary file independent of the recipient's hardware or software configuration. The newly amended limitation would contradict with the disclosure as original filed. The disclosure as originally filed does not disclose the newly added limitation.

Applicant is required to either provide support by original specification for "without independently of the source application" or cancel this limitation.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 7-15, 18-20, 27-35, 38-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Martin et al (us pat 6,272,484) (hereinafter Martin) in view of Shaffer et al (us 2002/0059347) (hereinafter Shaffer).

As regarding claim 7, Martin discloses process by the computing device the binary file (the binary file is an inherent feature since all of the files, does not matter what source application uses to create the file, when process by the computer, the computer will process the file in binary form) to generating by the computing device a self-contained representation of user interface displays of said binary file rendered when content of the binary file are viewed using the source application, by associating results of said processing of said binary file with the selected set of user interface display specification (see Martin col.9, lines 62-67 to col.10, lines 1-10, also see figure 6, the self-contained package 623 including the file itself and the viewer code (viewer code corresponds to the graphical representations)), to enable viewing of the user interface displays independently of the source application (see Martin col.11, lines 47-51, user can view the self-contain without any additional software).

Martin does not clearly teach identifying by a computing device a format of a binary file generated by a source application; selecting a set of user interface display

specifications from a plurality of sets of interface display specifications, based at least in part on the identified format of the binary file;

Shaffer teaches identifying by a computing device a format of a binary file generated by a source application (see Shaffer pg.2, par 0025, the binary file is inherently processed by the computer, the computer analyzing the file to identify the format of the file); selecting a set of user interface display specifications from a plurality of sets of interface display specifications, based at least in part on the identified format of the binary file (see Shaffer pg.2, par 0025, after analyzing the format of the file, compare it to a stored table of application suffixes, for example, .doc file may be associated with a Microsoft word, .PDF file may be associated with an Adobe Acrobat Reader).

It would have been obvious to one with ordinary skill in the art at the time the invention was made to combine the teaching of Shaffer to the method of Martin to identify the format of the binary file and selecting the representations of the binary file for the purpose of enhancing the email process (see Shaffer pg.1, par 0007).

As regarding claim 8, Martin-Shaffer discloses attaching by the computing device said self-contained representation with an electronic message (see Martin col.9, lines 33-36, electronically email the self-contained representation); and transmitting by the computing device said electronic message and said attached self-contained representation to one or more recipients for viewing, where the viewing includes rendering said user interface displays in accordance with said user interface display specifications and user input(s) (see Martin col.9, lines 21-39).

As regarding claim 9, Martin-Shaffer discloses binary file is either a word processing document or a spreadsheet document (see Martin col.10, lines 36-42).

As regarding claim 10, Martin-Shaffer discloses determining is based upon a filename extension associated with said binary file (see Shaffer pg.2, par 0025, file suffixes, .DOC, .PDF). The same motivation was utilize in claim 7 applied equally well to claim 10.

As regarding claim 11, Martin-Shaffer discloses launching by the computing device a locally accessible version of the application (see Shaffer pg.2, par 0025); simulating by the computing device user input(s) to said application based at least in part upon said selected set of user interface display specifications (see Shaffer pg.2, par 0025); and storing by the computing device output(s) from said application in response to said user input(s) (see Shaffer pg.2, par 0025). The same motivation was utilize in claim 7 applied equally well to claim 11.

As regarding claim 12, Martin-Shaffer teaches each specification includes one or more transition rules specifying one or more transitions to one or more other user

interface displays specified by one or more other specifications (see Martin col.10, lines 43-55).

As regarding claim 13, Martin-Shaffer discloses each transition rule specifies transition to another user interface display specified by another specification when the user interface displays enter a particular user interface display state (see Martin col.10, lines 43-55).

As regarding claim 14, Martin-Shaffer teaches each of said user interface displays comprises one or more display cells, and each of said specification comprises one or more display cell specifications correspondingly specifying the one or more display cells (see Martin col.10, lines 43-55).

As regarding claim 15, claim 15 contains limitations that are similar to the limitations of the rejected claim 1, Martin-Shaffer further discloses receiving, by a computing device, an email message including an associated first attachment of a first attachment type (see Martin pg.2, par 0025, receive the attachment, determine the format of the attachment); determining, by the computing device, whether said first attachment type is associated with a member of a group of one or more supported source applications (see Martin pg.2, par 0025, compare the file extension with the table of applications); selecting, by the computing device, a set of one or more user interface display specifications from a plurality of sets of one or more user interface display

specifications, based upon said first attachment type if it is determined said first attachment type is associated with a member of said group of one or more supported source applications (see Martin pg.2, par 0025, select the application if the match found); launching, by the computing device, a locally accessible version of the associated source application (see Martin pg.2-3, par 0025); simulating, by the computing device, one or more user input signals based upon said selected set of one or more user interface display specifications (see Martin pg.2-3, par 0025). The same motivation was utilized in claim 7 applied equally well to claim 15.

As regarding claim 18, Martin-Shaffer discloses a proprietary format (see Martin col.10, lines 34-42).

As regarding claim 19, Martin-Shaffer discloses each of said plurality of user interface displays comprises one or more display cells, and each of said user interface display specifications comprises one or more display cell specifications (see Martin col.10, lines 43-55).

As regarding claim 20, Cook discloses each of said user interface displays comprises one or more display cells, and each of said specification comprises one or more display cell specifications correspondingly specifying the one or more display cells (see Martin col.10, lines 43-55).

As regarding claims 27-35, 38-40, the limitations of claims 27-35, 38-40 are similar to the rejected claims 7-15, 18-20 therefore rejected for the same rationales.

Claims 16-17, 36-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Martin-Shaffer as applied to claims 15, 35 above and further in view of what was well known in the art.

As regarding claims 16-17, 36-37 Martin-Shaffer discloses the invention substantially as claim in claims 15, 35 above, Martin-Shaffer does not explicitly disclose encoding the attachment, wherein encoding that message using MIME protocol, transmit the encoded message and the attachment to the recipient.

Official Notice is taken (see MPEP 2144.03) concept of encoding that message using MIME protocol, and transmitting the encoded message and the attachment is well known at the time the invention was made.

It would have been obvious to one with ordinary skill in the art at the time the invention was made to combine the teaching of what was well known in the art to the method of Martin-Shaffer to encode the message and send the message with the attachment to recipient for the purpose of allowing quickly deliver the content message.

Conclusion

Examiner's Note: Examiner has cited particular columns and line numbers in the references applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to

specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

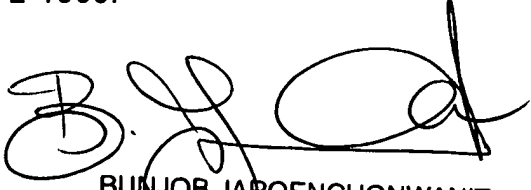
In the case of amending the claimed invention, Applicant is respectfully requested to indicate the portion(s) of the specification which dictate(s) the structure relied on for proper interpretation and also to verify and ascertain the metes and bounds of the claimed invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Duyen M. Doan whose telephone number is (571) 272-4226. The examiner can normally be reached on 9:30am-6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bunjob Jaroenchonwanit can be reached on (571) 272-3913. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Examiner
Duyen Doan
1/22/2008



BUNJOB JAROENCHONWANIT
SUPERVISORY PATENT EXAMINER